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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,053	10/22/2003	Chris Wimmer	MS1-1743US	6082

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EXAMINER	
GEE, JASON KAI YIN	
ART UNIT	**PAPER NUMBER**
2134	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	04/04/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/04/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/691,053	WIMMER, CHRIS	
	Examiner	Art Unit	
	Jason K. Gee	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is response to communication: application filed on 10/22/2003.

2. Claims 1-35 are currently pending in this application. Claims 1, 6, 19, and 31 are independent claims.

3. No IDS was received for this application.

Claim Objections

4. Claims 5, 10, and 30 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. As per these claims, the applicants recite that the video content is either digital or analog. This does not further limit the parent claim, as all video content is either in a digital or analog format.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

Claims 1-5, and 13-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claims 1-5, the claims recite including a personal identifier in the video content. The term "including a personal identifier" is unclear, as the metes and bounds of the term "including" are not clear, and is therefore indefinite.

As per claim 13, the claim recites "for each of at least some." This phrase is unclear and indefinite.

As per claims 14-18, the claims recite the term "proportional." The term "proportional" is a relative term and renders the claim indefinite. The metes and bounds of the claims are unclear.

As per claims 19-29, the independent claim recites "wherein if the video content comprises parts." It is unclear what a "part" is. A video inherently contains "parts," as a video is made up of at least 2 frames.

As per claims 28-29, claim 28 recites "the metadata." There is insufficient antecedent basis for this term.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> **Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

7. Claims 1-4 and 31-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claims 1-4, the applicants claim a method of receiving a video and including an identifier. However, there is no tangible result from these claims, as the act of including an identifier is unclear and by itself does not result in a tangible result.

As per claims 31-35, the applicants claim a computer readable media containing instructions are executable by a computer to receive an identifier and to associate the identifier. There is no tangible result of this claim, as associating identifiers and video content do not produce a result. Therefore, these claims are directed toward non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1, 5-10, 19, 24, and 30-35 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Patton et al. US Patent Application Publication 2003/0016842 (hereinafter Patton).

As per claim 1, Patton teaches a method comprising: receiving video content to be protected from redistribution (taught throughout the reference, such as in paragraphs 30, 32, 36 41; Figure 7); and including a personal identifier in a video content (paragraph 31), wherein the personal identifier identifies a user of the video content (paragraph 31) and wherein the personal identifier is visible when the video content is displayed (paragraph 30 and Figures 6A and 6B).

As per claim 5, Patton teaches wherein receiving video content includes receiving one of digital or analog video content (paragraph 30, wherein video content is taught, which inherently must be digital or analog).

As per claim 6, Patton teaches a method, comprising: receiving video content in a client device (taught throughout the reference, such as in paragraphs 30, 32, 36 41; Figure 7); adding a personal identifier to the video content, wherein the personal identifier signifies personal identity information on an owner of the client device (paragraphs 30, 31).

As per claim 7, Patton teaches including the personal identifier in the video content when the client device outputs the video content (Figure 6A and 6B).

As per claim 8, Patton teaches wherein the client device outputs the video content by displaying the video content (Figures 6A and 6B).

As per claim 9, Patton teaches wherein the client device is one of a television, a television set-top box, a personal computer, a personal digital assistant, a digital versatile disk player, or a personal video recorder (paragraph 52).

Claim 10 is rejected using the same basis of arguments used to reject claim 5 above.

As per independent claim 19, Pattont eaches a branding engine for video content, comprising: a brand generator to produce a brand, wherein a brand includes at least one piece of personal identity information about a user of the video content (paragraphs 31, 33); a branding decision engine, wherein if the video content comprises parts, then to decide which parts of the video content are to receive a brand (paragraphs 34, 59); and an overly generator to place the brand in the video content (paragraphs 33, 38).

As per claim 24, Patton teaches further comprising a database of personal identity information about the user communicatively coupled with the branding decision engine (paragraph 58).

Claim 30 is rejected using the same basis of arguments used to reject claim 5 above.

Independent claim 31 is rejected using the same basis of arguments used to reject claim 1 above and is clearly taught throughout Patton. Computer readable media containing instructions that are executable by a computer to perform such actions are inherent to the system taught in Patton, as Patton utilizes actions that are performed on a computer.

Claim 32 is rejected using the same basis of arguments used to reject claim 8 above. This is also shown in Patton Figures 6A and 6B.

As per claim 33, Patton teaches wherein the image of the personal identifier overlays the video content when the video content is displayed (Figures 6A and 6B).

Claim 34 is rejected using the same basis of arugments used to reject claims 7, 8, and 34.

As per claim 35, Patton teaches adding the personal identifier as a video signal to the video content and outputting the video content and the personal identifier (taught throughout Patton, such as in paragraphs 30-36 and Figures 6A and 6B.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 2 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton as applied above, and in view of Yoshida US Patent No. 6,411,712 (hereinafter Yoshida).

As per claim 2, Patton does not explicitly teach wherein the video content includes multiple programs. Multiple programs in a video content is well known in the art. Yoshida teaches the use of multiple programs in a video content throughout the

reference, such as in Figure 23 a-e. More information may be found in col. 31 lines 30-43.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include multiple programs in a video content. One of ordinary skill in the art would have been motivated to perform such an addition to be able to supply multiple programs to a user so that he may have a variety of programs to view. Also, by supplying multiple programs, programs may be free or some may be paid for, as taught in Yoshida col. 1 lines 36-49.

Claim 11 is rejected using the same basis of arguments used to reject claim 2 above.

12. Claims 3, 4, 13-16, and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton and Yoshida as applied above, and further in view of Stone US Patent Application Publication 2002/0080964 (hereinafter Stone).

As per claim 3, Patton teaches throughout the reference the addition of personal identifiers, and Yoshida teaches a way to distinguish between free and subscription video programs. Also, Patton teaches that the system can determine whether or not to embed a personal identifier in paragraph 59: The Patton combination does not explicitly teach the use of metadata. However, metadata, and a distinguishment between free

and bought metadata is by Stone throughout the reference, such as in paragraph 120-121.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include metadata. One of ordinary skill in the art would have been motivated to perform such an addition to be able to include additional information to distinguish between programs, as it would provide clarity.

As per claim 4, Stone teaches in paragraph 120 that the metadata is electronic program guide information.

As per claim 13, Yoshida teaches throughout the reference of free and subscription programs. The free programs would have low levels of security (as they are not encrypted, as taught throughout the reference), and the subscription programs would have high security levels (as they are encrypted). Metadata is taught in Stone as shown in the rejection for claim 3 above, and as seen in paragraph 120, free and bought metadata can be distinguished.

As per claim 14, as best understood by the Examiner, Patton teaches the amount of the personal identity information added to a program is proportional to the security level of the program (paragraph 59).

As per claim 15, as best understood by the Examiner, Patton teaches wherein the displayed size of a personal identity information added to a program is proportional to the security level of the program (wherein if the value of n=0, the size would be zero).

As per claim 16, as best understood by the Examiner, Patton teaches wherein the visibility of a location of the personal identity information within a displayed image of

the program is proportional to the security level of the program (paragraph 59, wherein if the value of "n" is 0, the visibility of a location would be zero, and if n is greater than 1, the visibility of the location can be seen).

As per claim 20, Stone teaches being able to read metadata about the video content, which would inherently require a metadata reader. Security information of whether to brand the video is taught throughout Patton and Yoshida, such as in Patton 59. Yoshida teaches throughout the reference a system which can decide which program to encrypt or remain unencrypted (such as with subscription and free programs).

As per claim 21, Yoshida teaches distinguishing between secure and non-secure programs, and Patton teaches a decision whether to brand the video or not, in paragraph 59.

As per claim 22, Patton teaches wherein the security information includes a security level for a program within the video content (paragraph 59), wherein the security level determines characteristics of the brand to be added to the program (paragraph 59). Yoshida also teaches the security levels of the different programs (level of secure/encrypted and free/unencrypted).

Claim 23 is rejected using the same basis of arguments used to reject claims 14-16.

13. 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton, Yoshida, and Stone as applied above, and further in view of Schmelzer US Patent Application Publication 2003/0037010 (hereinafter Schmelzer).

As per claim 17, the Patton combination teaches metadata, but does not explicitly teach wherein the metadata includes a record of the user's history of unauthorized redistribution of a video content. However, a record of the user's history of unauthorized redistribution of a video content is well known in the art, as taught throughout Shmelzer, such as in paragraph 74.

At the time of the invention, it would have been obvious to combine the teachings of Schmeizer with the Patton combination. One of ordinary skill in the art would have been motivated to take into account a user's fraudulent history to be able to ensure that the valued content is safe by determining if further protective actions need to be performed on the valued content.

As per claim 18, Schmelzer teaches taking further action when a related fraudulent history record of a user is detected in paragraph 74. The variance in display factors are rejected as shown in the rejections for claims 14-17 above.

14. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Patton as applied above, and in view of Simpson et al. US Patent Application Publication 2003/0165253 (hereinafter Simpson).

As per claim 25, Patton and Simpson do not explicitly teach a store of identifiers associated with the database of personal identity information. However, a store of identifiers that are used for embedding is taught in Simpson throughout the reference, such as in paragraphs 16, 31, 32.

At the time of the invention, it would have been obvious to include a store of identifiers that are associated with a user. One of ordinary skill in the art would have been motivated to perform such an addition to be able to associate images that are to be embedded easily. Simpson is also directed toward embedding visual watermarks to protect from distribution.

15. Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton and Simpson as applied above, and further in view of Schmelzer US Patent Application Publication 2003/0037010 (hereinafter Schmelzer).

As per claim 26, Patton and Simpson teach a database of personal identity information, but does not explicitly teach a record of the user's history of unauthorized redistribution. This is taught though in Schmelzer, such as in paragraph 74.

At the time of the invention, it would have been obvious to combine the teachings of Schmeizer with the Patton combination. One of ordinary skill in the art would have been motivated to take into account a user's fraudulent history to be able to ensure that the valued content is safe by determining if further protective actions need to be performed on the valued content.

As per claim 27, Patton teaches making a branding decision (paragraph 59). Schmelzer teaches that actions can be determined based on the record of the user's history (paragraph 74).

16. Claims 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patton, Simpson, and Schmelzer as applied above, and further in view of Stone US Patent Application Publication 2002/0080964 (hereinafter Stone).

As per claim 28, Patton teaches making a branding decision (paragraph 59) based on security levels. However, the use of metadata is not taught. Metadata, such as free and bought metadata, is taught throughout Stone, such as in paragraphs 120-121.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to include metadata. One of ordinary skill in the art would have been motivated to perform such an addition to be able to include additional information to distinguish between programs, as it would provide clarity and more security for the programs that need to be secured..

Claim 29 is rejected using the same basis of arguments used to reject claim 23 above.

Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason K. Gee whose telephone number is (571) 272-6431. The examiner can normally be reached on M-F, 7:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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03/27/2007

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